

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Y. ALMOG, et al.
 Serial Number: 09/529,289
 Filed: April 7, 2000
 Art Unit: COATING SYSTEM FOR SUBSTRATES
 Examiner: 1774 L. XU

Honorable Commissioner of Patents and Trademarks
Washington DC 20231

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PETITION UNDER 37 CFR §1.144

Sir:

In the above referenced application the Examiner has found that lack of unity of invention exists between claim 1 (group 1), claim 30 (Group 2) and claim 37 (Group 3). This is a petition against that finding.

Claim 1 reads:

1. A substrate suitable for printing a toner image thereon, comprising:
a sheet of plastic;
an underlayer coating, on the sheet of plastic, comprising a first polymer material comprising a polymer chosen from the group consisting of amine terminated polyamide, a silane coupling agent and amino propyl triethoxy silane;
an overlayer coating, directly on the underlayer, comprising a second polymer material and having an outer surface to which a toner image can be fused and fixed.

Claim 30 reads:

30. A method of producing a coated substrate which a toner image can be adhered comprising:
coating a sheet of plastic with a first polymer material as an underlayer, the underlayer comprising a polymer chosen from the group consisting of amine terminated polyamide, a silane coupling agent and amino propyl triethoxy silane;
directly overcoating the underlayer with an second polymer material to form an overlayer coating on the underlayer, the overlayer having an outer surface to which a toner image can be adhered and fixed.

Claim 37 reads:

37. A printing method comprising:
providing a substrate according to claim 1 or produced according to claim 30 or claim 45; and
printing a toner image on the substrate.

Claim 1 is a claim for a coated substrate in which a plastic sheet is coated with two layers, the underlayer having a specified chemical composition and the overlayer has a functional characteristic. Claim 30 is a process of producing a substrate in which the end result of the method is the substrate of claim 1. Applicants submit that this process is "especially adapted" for producing the substrate of claim 1 as that term is defined in MPEP §1893.03 (d). Claim 37 is a method of using the substrate of claim 1 or the substrate produced according to claim 30.

According to 37 C.F.R. §1.475 (b) (3) this combination of product, method of manufacture and method of use has unity of invention. As stated in 37 C.F.R. §1.475 (b):

"(b) An international or a national stage application containing claims to different categories of invention *will be considered to have unity of invention* if the claims are drawn only to one of the following combinations of categories:

(3) A product, a process specially adapted for the manufacture of the said product and a use of said product;...

Applicants submit that the wording of 37 C.F.R. §1.475 (b) (3) is such that it *absolutely* provides unity of invention, so long as all the claims meet the stated requirements, as they do in the present case.

The Examiner in this case (who was replaced by a second examiner who maintains the finding of lack of unity of invention) and the Examiner's supervisor (to whom the undersigned has spoken about this case), all feel that if claim 1 is unpatentable, then non-unity of invention exists, since there is "special technical feature" linking the claims. As indicated above, 37 C.F.R. §1.475 does not require such a feature, if the requirements of 37 C.F.R. §1.475 (b) are met.

Apparently, the Examiner is basing the lack of unity finding on 37 C.F.R. §1.475(a), without considering 37 C.F.R. §1.475(b). Applicants submit that even the interpretation of 37 C.F.R. §1.475 (a) by the Examiner is incorrect. Firstly, the reasoning used would mean that if claim 1 were considered to be unpatentable, then claim 2, which shares the features of claim 1, would not have unity of invention with claim 1. The fact that the claims are for different categories does not change the situation, since 37 C.F.R. §1.475 (a) says nothing about different categories.

Furthermore, were this reasoning to be followed, additional paradoxical situations could result. For example, if a method and apparatus to the *same* subject matter were claimed, non-unity could be indicated, which would be an unacceptable result since it could result in separate patents to identical inventions, once the claims were amended or argued to be patentable. In fact, in those jurisdictions where non-unity of invention is the general criteria for requiring divisional

applications (such as the EPO), non-unity is declared only if the claims do not have a common special technical feature but do have *different* special technical features.

Furthermore, claims 37-41 are dependent claims. Applicants submit that non-unity cannot exist between a parent claim and a claim dependent on it, since, by definition, the dependent claims have the features of the parent claims.

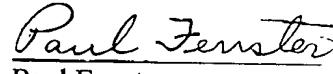
If the Examiner's position were upheld, there could be three patents to claims 1, 30 and 37, which could be considered to be problematic under present guidelines of double patenting.

Furthermore, the Examiner's finding of lack of unity is based on his conclusion that "the special technical feature shared by these three groups, does not define a contribution over the prior art, Keil, as stated in the prior office action." This indicates that claim 1 is anticipated (or at least made obvious) by Keil. However, the Examiner himself does not reject claim 1 as being anticipated or obvious over Keil, by itself, in the office action. Thus, the alleged factual basis of the finding is itself incorrect. In fact, Claim 1 defines a specific group of materials as forming the underlayer of claim 1. The Examiner, in the rejection under 35 U.S.C. §102, of claims other than claim 1 cites the reference as teaching coating materials, none of which are claimed as being in the underlayer of claim 1. Rather these materials are in the overlayer coating as claimed in claim 4, which has been cancelled.

The Examiner also rejects claim 1 based on a combination of references, which applicants submit (in a separate response to the outstanding action) do not provide a *prima facie* case of non-patentability.

Applicants submit that the finding of lack of unity is improper and that all of the claims should be examined together. A ruling vacating the finding of lack of unity and directing the Examiner to examine all the claims presently in the application is respectfully solicited. Applicants believe that no petition fee is due. If the Commissioner deems otherwise, he is authorized to charge deposit account number 03-3419 accordingly.

Respectfully submitted,
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